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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/739,080	12/15/2000	Gary A. Lenz	F12.12-0045	3258

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EXAMINER

BUTLER, MICHAEL E

ART UNIT

PAPER NUMBER

3653

DATE MAILED: 08/08/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/739,080

Applicant(s)
Lenz et al.

Examiner
Michael E. Butler

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on May 8, 2002
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-53 is/are pending in the application.
- 4a) Of the above, claim(s) 1-32, 37, 38, 40-48, and 50-53 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 33-36, 39, and 49 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirements.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 4-8 6) ☐ Other: _____

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DETAILED ACTION

Priority

1. Applicant's claim(s) of priority to provisional application 60/170987 filed 12/15/99 is acknowledged.

Drawings

2. New drawings will be required contingent upon allowance because the drawings were declared informal by the applicant.

Election/Restriction

3. The Species requirement was modified during an April 12 interview with applicant's representative as follows:

Species 1: an ID card personalization device having a web server for serving data;

Species 2: an ID card personalization device having a web client for data.

4. Applicant's election of species II reading upon claims 33-53 without traverse in Paper No. 11 is acknowledged. Applicant asserts the examiner's figure isolation per initial species requirement differs from applicant's identification at least per the modified species requirement.

5. Applicant's election of invention II with traverse of the restriction requirement in Paper No. 11 is acknowledged.

6. Claims 1-32 are withdrawn from consideration as being directed at a non-elected species. Claims 37-38, 40-48, and 50-53 are withdrawn from consideration as being directed at a non-elected invention.

7. The applicant argues the claims are sufficiently novel as to qualify as a linking claim to the dependent groups. This argument relates to rejoinder of non-elected claims

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rather than the presence vs. absence of patentable distinction. A general attribute of dependent claims is that they contain the limitations of their base claims. If the base claim(s) define over the prior art, the dependent claim(s) define over that same art without examination, so rejoinder of the claims occurs (excepting such situations as the base claim chronologically overcoming the prior art via a 131 affidavit or continuity portion of a CIP while subsequently invented dependent claims fail to overcome the intervening prior art). If the base claim defines over the prior art, it would then qualify as a linking claim. If the base claim fails to define over the prior art, it fails to qualify as a linking claim. The test however, is patentability rather than novelty as advanced by the applicant in the traversal.

Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Accordingly, the restriction and election of species requirements are made final.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

- (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.
- (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States
- (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

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9. Claims 33-34, 39, and 49 are rejected under 35 U.S.C. 102(b) as being anticipated by OrdaCard which discloses:

(re: cl 33) An ID card personalization device comprising: a card print mechanism (L2), a network and adapter (L1 & L2-4), web client (L13);
(re: cl 34) web browser subscribed to data for web client (L3);
(re: cl 39) data subscription services (L3, enrollment)
(re: cl 49) web server for serving data (L 13).

10. Claims 33-34, 39, and 49 are rejected under 35 U.S.C. 102(e) as being anticipated by Provost which discloses:

(re: cl 33) An ID card personalization device comprising: a card print mechanism (106), a network and adapter, web client (c5 L 29-40);
(re: cl 34) web browser subscribed to data for web client (c 14 L39-53);
(re: cl 39) data subscription services (c5 L 29-40);
(re: cl 49) web server for serving data (c5 L 29-40).

11. Claims 33-34, and 49 are rejected under 35 U.S.C. 102(b) as being anticipated by Watanabe. Watanabe discloses:

(re: cl 33) An ID card personalization device comprising: a card print mechanism (c2 L 49-53), a network and adapter (c4 L 27-43), web client (39);
(re: cl 34) web browser subscribed to data for web client (c 5 L 23-40);
(re: cl 49) web server for serving data (38).

12. Claims 33 and 49 are rejected under 35 U.S.C. 102(b) as being anticipated by D'Entremont et al. which discloses:

(re: cl 33) An ID card personalization device comprising: a card print mechanism (c 6 L 7-36), a network and adapter (c7 L 8-17), web client (22);
(re: cl 49) web server for serving data (20; c6 L50-63).

Claim Rejections - 35 USC § 103

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made

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to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Claims 33-36, 39, and 49 are rejected under 35 U.S.C. 103(a) as being unpatentable over OrdaCard in view of Knowlton '692, with OrdaCard disclosing the elements previously discussed and further disclosing:

Knowlton '692 discloses the elements not inherently disclosed by OrdaCard of:

(re: cl 35) web page containing links to information (c11 L 14-36);
(re: cl 36) links are selected from the group: html and xml (c 11 L 14-36).

It would have been obvious at the time of the invention for OrdaCard to use web pages containing links so as to allow wide-based and disparate customers the opportunity to place orders from remote locations and it would have been obvious to use a universally used common language as HTML to permit those divers customers the opportunity to place orders remotely as taught by Knowlton '692 and come up with the instant invention.

15. Claims 33-36, 39, and 49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Provost in view of Knowlton '692, with Provost disclosing the elements previously discussed and further disclosing:

Knowlton '692 discloses the elements not inherently disclosed by Provost of:

(re: cl 35) web page containing links to information (c11 L 14-36);
(re: cl 36) links are selected from the group: html and xml (c 11 L 14-36).

It would have been obvious at the time of the invention for Provost to use web pages containing links so as to allow wide-based and disparate customers the opportunity to place orders from remote locations and it would have been obvious to use a universally used common language as HTML to permit those divers customers the opportunity to

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place orders remotely as taught by Knowlton '692 and come up with the instant invention.

Conclusion

16. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Exmr. Michael E. Butler whose telephone number is (703) 308-8344.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Donald Walsh, can be reached on (703) 306-4173. The fax number for the Group is (703) 305-7687.

Michael E. Butler

Michael E. Butler

Examiner

Donald E. Walsh
DONALD E. WALSH
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600